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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/461,698	12/14/1999	STUART KAMILLE	03004.P007	4156

7590 01/27/2004

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EXAMINER
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CHAMPAGNE, DONALD

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 01/27/2004

15

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/461,698

**Applicant(s)**

KAMILLE, STUART

**Examiner**

Donald L. Champagne

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 25-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 25-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 December 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### Withdrawal of Final Rejection

1. Amendment D filed after final rejection on 30 May 2003 (Paper No. 14) attempted to place this application into condition for allowance, as indicated in the last Office actions (Papers No. 10 and 12 mailed respectively on 31 January and 28 April 2003). The final rejection was accordingly withdrawn and Amendment D was entered. Upon further examination, the claims were found not to be allowable. A new non-final rejection follows.

### ***Claim Rejections - 35 USC § 102 and 35 USC § 103***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 25-30 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Irwin, Jr. et al. (US pat. 5,621,200 A).
5. Irwin, Jr. et al. teaches (independent claim 25) a method of determining the authenticity and integrity of a document, which may be a coupon (col. 3 line 61 and col. 5 lines 59-60), which reads on scoring a coupon, comprising: determining the electrical characteristics of the document/coupon (col. 6 lines 5-8) or scanning a bar code (col. 7 line 47), which reads on scanning a coupon, said document/coupon including a first field **354** having *rules 348* and at least one *overprint area 356* on top of a removable concealer (*scratchoff coating 350*; col. 21 line 45 to col. 22 line 4 and Fig. 26), and a second field **76** (col. 7 lines 34-35 and Fig. 1); ensuring that a predetermined number of *overprint areas 356* corresponding to the *rules 348*

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is selected by removal of the removable concealer **350** in the first field (col. 18 lines 18-24 and col. 29 lines 12-21); and ensuring that the overprint area **76** has not been tampered with, which reads on ensuring that only a predetermined number (zero) of areas is selected by removal of the removable concealer in the second field.

6. Irwin, Jr. et al. does not explicitly teach that the rules 348 comprise at least one question and overprint areas 356 comprise at least one answer. However, under the principles of inherency (MPEP § 2112.02), since the reference invention necessarily performs the method claimed, the method claimed is considered to be anticipated by the reference invention. As evidence tending to show inherency, it is noted that the *rules 348/overprint areas 356* is a pairing of stimulus/response that is functionally equivalent to questions/answers. Alternatively, because the question/answer format is easy to understand, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to write the *rules 348* and *overprint areas 356* in a question/answer format.
7. Irwin, Jr. et al. also teaches at the citations given above claims 29 and 30, because ascertaining validity reads on assigning a value or a quantity to the coupon. Irwin, Jr. et al. also teaches claims 26-28 (col. 7 lines 33-35 and 47-49).
8. Claim 31 is rejected under 35 U.S.C. 103(a) as obvious over Irwin, Jr. et al. Irwin, Jr. et al. does not teach assignee a free item to the coupon based on the information revealed by removing the second field concealer. Because free items were common benefits of coupons, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to assign a free item to the coupon based on the information revealed by removing the second field concealer.

### **Conclusion**

9. **COPY of REFERENCES** - Applicant is entitled to receive a copy of every reference cited by the examiner (except at allowance; MPEP 707.05(a)). Applicant should contact the examiner if a completed form PTO-892 is enclosed, but the cited references are not.
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 703-308-3331. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at [donald.champagne@uspto.gov](mailto:donald.champagne@uspto.gov), and *informal*

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fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 703-746-5536.

11. The examiner's supervisor, Eric Stamber, can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5771.
12. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, [www.uspto.gov](http://www.uspto.gov). At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.



Donald L. Champagne  
Examiner  
Art Unit 3622

22 January 2004